PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Christopher W. Blackburn et al.	Examiner: Malina K. Rustemeyer
Serial No.: 10/802,700	Group Art Unit: 3714
Filed: March 17, 2004	Docket: 1842.028US1

For: NAME SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT

REINSTATED APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Reinstated Appeal Brief is presented in support of the Reinstated Notice of Appeal to the Board of Patent Appeals and Interferences, filed on February 16, 2010, from the Final Rejection of claims 1-7 and 11-21 of the above-identified application, as set forth in the Office Action dated September 15, 2009.

The Appellant has paid the fees associated with the previous Notice of Appeal and Appeal Brief, and believes that no further fees are due at this time. If further fees are in fact due, the Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 for any required amount. The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

REINSTATED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, WMS GAMING INC.

2. RELATED APPEALS AND INTERFERENCES

The following patent applications are related to the above-identified application, are currently appealed to the Board, and may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by the Board as of the filing of this Appeal Brief.

App. Serial #	Attorney Docket	Title
10/813,653	1842.017US1	EVENT MANAGEMENT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/562,411	1842.019US1	GAMING NETWORK ENVIRONMENT PROVIDING A CASHLESS GAMING SERVICE
10/788,903	1842.020US1	A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/788,661	1842.021US1	GAMING MANAGEMENT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/788,902	1842.022US1	GAME UPDATE SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/794,723	1842.024US1	DISCOVERY SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/794,422	1842.025US1	BOOT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/796,562	1842.027US1	AUTHORIZATION SERVICE IN A SERVICE-ORIENTED GAMING NETWORK
10/802,701	1842.029US1	TIME SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/802,537	1842.031US1	MESSAGE DIRECTOR SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT

3. STATUS OF THE CLAIMS

The present application was filed on March 17, 2004 with claims 1-25. A non-final Office Action mailed September 12, 2007 rejected claims 1-25. Claims 8-10 and 22-25 were canceled in a response to the non-final Office Action filed March 12, 2008. A Final Office Action was mailed July 9, 2008 rejecting claims 1-7 and 11-21. A second non-final Office Action dated September 15, 2009 (hereinafter "the Office Action") rejected claims 1-7 and 11-21. Pending claims 1-7 and 11-21 stand at least twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Office Action dated September 15, 2009.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, systems and methods that provide a name service in a service-oriented gaming network environment. In general, the independent claims recite systems and methods that provide a three party handshake for providing a name service on a wagering game network. The name service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the name service and in response publishes the service information for the name service. A client such as a wagering game machine desiring to use the name service obtains the service information for the name service from the discovery agent and uses the service information to contact and utilize the name service.

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal . . .." Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

INDEPENDENT CLAIM 1

1. A method for providing a name service in a gaming network including gaming machines, the method comprising:

instantiating a name service on the gaming network; *[see e.g., FIG. 5A, element 510; page 17 line 17 to page 19, line 2; and page 19, lines 21-26]*

sending service information for the name service from the name service to a discovery agent on the gaming network, wherein the name service provides identification services using common names for devices on the gaming network to a plurality of gaming clients communicably coupled to the gaming network, the gaming clients including one or more gaming machines, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game; *[see e.g., FIGs. 1-2, element 10; FIG. 3, elements 302,304 and 306; Fig. 5B, elements 501, 502 and 504; page 5, line 9 to page 6, line 14; and page 17 line 17 to page 19, line 2]*

determining by the discovery agent if the name service is authentic and authorized; *[see e.g., page 7, lines 22-27; and page 16, lines 9-15]*

in response to determining that the name service is authentic and authorized, publishing service information to a service repository to make the name service available on the gaming network; *[see e.g., FIG. 3, elements 324 and 326; page 11, lines 15-27; and page 16, lines 9-15]*

receiving by the discovery agent a request for the location of the name service from a gaming client; *[see e.g., FIG. 3, elements 302, 306, 312, 332, 306 and 326; page 11, lines 15-27]*

returning the service information for the name service to the gaming client; *[see e.g., FIG. 3, elements 302, 306, 312, 326 and 332; and page 11, lines 15-27]*

sending one or more service requests using the service information from the gaming client to the name service; and *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 5B, elements 501 and 502; page 16, line 24 to page 17, line 2; and page 21, lines 10-13]*

processing the one or more service requests between the gaming client and the name service, said service requests conforming to an internetworking protocol. *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 4, element 400; FIG. 5B, elements 501, 502, and 503; page 12, line 6 to page 13, line 20; page 16, lines 16-23; and page 21, lines 10-21]*

INDEPENDENT CLAIM 15

15. A gaming network system providing a name service, the gaming network system comprising:

a gaming client communicably coupled to the gaming network; *[see e.g., FIGs. 1 and 2, element 10; FIG. 3, element 302; FIG. 5B element 501; page 5, line 9 to page 6, line 14; page 11, lines 12-14]*

a name service communicably coupled to the gaming network and operable to provide identification services using common names for devices on the gaming network to a plurality of gaming clients; and *[see e.g., FIG. 3, element 304; FIG. 5A, element 510; and page 17 line 17 to page 19, line 2]*

a discovery agent communicably coupled to the gaming network, the discovery agent operable to: *[see e.g., FIG. 3, element 306; and page 11, lines 15-27]*

receive service information from the name service, *[see e.g., FIG. 3, elements 304, 322 and 330; and page 11, lines 15-27]*

determine if the name service is authentic and authorized for the gaming network, and *[see e.g., page 7, lines 22-27; and page 16, lines 9-15]*

publish the service information to a service repository to make the name service available on the gaming network; *[see e.g., FIG. 3, elements 324 and 326; FIG. 5B, elements 501 and 502; page 11, lines 15-27; and page 16, lines 9-15]*

wherein the gaming client is operable to issue a request for the location of the name service to the discovery agent and use the service information received from the discovery agent to send one or more service requests to the name service; *[see e.g., FIG. 3, elements 302, 306, 312, 326, 332 and 334; page 11, lines 15-27; page 16, line 24 to page 17, line 2; and page 21, lines 10-13]*

wherein the name service is further operable to:

receiving the one or more service requests from the gaming client; and *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 5B, elements 501 and 502; page 16, line 24 to page 17, line 2; and page 21, lines 10-13]*

processing the one or more service requests between the gaming client and the name service, said service requests conforming to an internetworking protocol. *[see e.g., FIG. 3, elements 302,304 and 334; FIG. 4, element 400; FIG. 5E, elements 501,502, and 503; page 12, line 6 to page 13, line 20; page 16, lines 16-23; and page 21, lines 10-21]*

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cordero (U.S. Published Application 2001/0044339 A1) in view of Gatto et al. (U.S. Patent 6,916,247).

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. § 103

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.,* 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The Federal Circuit has stated:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).
>
> *In re Fine*, 837 F.2d 1071; 5 USPQ2d 1596 (Fed. Cir.1988).

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007).

Further, conclusions of obviousness must be based on facts, not generality. *In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967); *In re Freed*, 425 F.2d 785, 787 (C.C.P.A. 1970). In fact, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. The Federal Circuit has stated that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn,* 441 F. 3d 977, 988 (Fed. Cir. 2006), citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir.2002); 72 FR 57527-28 (Oct. 10, 2007).

Moreover, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn,* 441 F. 3d 977, 988 (Fed. Cir. 2006). This was recently echoed by the U.S. Supreme Court in *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.).

B) The Application of 35 U.S.C. § 103(a) to the Rejection of Claims 1-7 and 11-21

Claims 1-7 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cordero (U.S. Published Application 2001/0044339 A1, hereinafter "Cordero") in view of Gatto et al. (U.S. Patent 6,916,247, hereinafter "Gatto"). Appellant respectfully traverses the rejections in view of the differences between Appellant's claims at issue and the cited references. In general, the independent claims recite systems and methods that provide a three party handshake for providing a name service on a wagering game network. The name service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the name service and in response publishes the service information, and a client such as a wagering game machine desiring to use the name service obtains the service information from the discovery agent and uses the service information to contact the name service. Appellant respectfully submits that when the claims are considered as a whole, the cited references do not disclose, teach or suggest the inventive subject matter presented in the claims.

For example, independent claim 1 recites "sending service information for the name service from the name service to a discovery agent on the gaming network." Claim 15 recites similar elements regarding a name service sending service information to a discovery agent. The Office Action states that Cordero, at paragraph [0045] discloses "sending service information for the name service from the name service to a discovery agent on the gaming network."[1] Appellant respectfully disagrees with this interpretation of Cordero. With respect to the name service, paragraph [0045] of Cordero states as follows:

> For example, the ideal service finder 130 and name service component 202 provide functionality to identify and locate, via symbolic names

[1] Office Action at page 2

> provided in a database on the ideal service finder 130, various resources and other functionality not provided via the special purpose software on the client computer 200. For example, a game server 134 may be provided as part of the primary data center 20 and also as part of a public server 1320. During game play, the client computer 200 may require information from a game server 134 that can be provided to that player from a game server 134 located on a public server 1320 that is geographically closer to the player than the game server 134 in the primary data center 20. The ideal service finder functionality facilitates the location of that closer game server 134. The use of symbolic names by the ideal service finder functionality eliminates the need to hard-code a network location for game servers and thus permits movement of the network location of the desired resource or functionality. More than one ideal service finder 130 may be provided in the system 100 (i.e., an ideal service finder 130 may be provided in both the primary data centers 20 and public server 1320). If more than one ideal service finder 130 is provided, the database of symbolic names is replicated to all ideal service finders 130 in the system 100.

Significantly absent from the text of paragraph [0045] is any disclosure or any mention of a discovery service. In fact, there is no use of the term "discovery service" or "discover" anywhere in Cordero. In the event that the Office Action is equating the ideal service finder with a discovery service, Appellant notes that Cordero does not disclose how the ideal service finder obtains information about services. Thus Cordero cannot disclose "sending service information for the name service from the name service to a discovery agent on the gaming network" as recited in claim 1 and similarly recited in claim 15.

Further, claim 1 recites "determining by the discovery agent if the name service is authentic and authorized." Claim 15 recites similar language with respect to a discovery agent authenticating and authorizing a name service. The Office Action correctly states that "Cordero lacks teaching the system including wagering games and lacks teaching details of security and authentication."[2] However, the Office Action attempts to make up for the deficiency in Cordero by stating that Gatto, at column 2, lines 54-61, "discloses determining by the discovery agent if the name service is authentic and authorized."[3] Appellant respectfully disagrees. The cited portion of Gatto states "[t]he gaming system may further include a Certificate Authority and communications from the plurality of specialized devices to the central server may be

[2] Office Action at page 3
[3] Id

authenticated by the Certificate Authority." Appellant notes that the cited portion is referring to authentication of communications between devices and a server. Notably absent from the cited portion is any mention of authorization of any kind. Further, the cited portion states that communications are authenticated, not services. In order to authenticate communications, the service has to be resident on the network. Appellant's claimed subject matter has the advantage that it determines whether or not a service is authorized and authentic before the service's details are ever published and made available on the network. In other words, the claims recite authentication and authorization of the service itself, not communications. Thus column 2, lines 54-61 of Gatto fails to teach or suggest determining by the discovery agent if the name service is authentic and authorized.

Moreover, there is no disclosure in Gatto that a discovery agent performs authentication and authorization of a name service prior to publishing the name service for a gaming network.

For all of the above reasons, claims 1 and 15 recite multiple elements that are not disclosed in Cordero or Gatto, either alone or in combination. Therefore claims 1 and 15 provide differences over the combination, and are not obvious in view of the combination of Cordero and Gatto. Appellant respectfully requests reversal of the rejection of claims 1 and 15.

Claims 2-7 and 11-14 depend from claim 1 and claims 16-21 depend from claim 15. These dependent claims inherit the elements of their respective base claims 1 and 15 and are not obvious in view of the combination of Cordero and Gatto for at least the reasons discussed above regarding their respective base claims and are also patentable in view of the additional elements which they provide to the patentable combination. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03. Appellant respectfully requests reversal of the rejection of claims 2-13 and 15-26.

SUMMARY

For the reasons argued above, claims 1-7 and 11-21 were not properly rejected under 35 U.S.C § 103(a) as being obvious over Cordero in view of Gatto. It is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Reversal of the rejections and allowance of the pending claims are respectfully requested.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402

Date August 16, 2010

By /R. L. Lacy/
Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 16th day of August 2010.

Anne M. Richards

Name

/Anne M. Richards/

Signature

8. CLAIMS APPENDIX

1. A method for providing a name service in a gaming network including gaming machines, the method comprising:

instantiating a name service on the gaming network;

sending service information for the name service from the name service to a discovery agent on the gaming network, wherein the name service provides identification services using common names for devices on the gaming network to a plurality of gaming clients communicably coupled to the gaming network, the gaming clients including one or more gaming machines, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game;

determining by the discovery agent if the name service is authentic and authorized;

in response to determining that the name service is authentic and authorized, publishing service information to a service repository to make the name service available on the gaming network;

receiving by the discovery agent a request for the location of the name service from a gaming client;

returning the service information for the name service to the gaming client;

sending one or more service requests using the service information from the gaming client to the name service; and

processing the one or more service requests between the gaming client and the name service, said service requests conforming to an internetworking protocol.

2. The method of claim 1, wherein the name service comprises a web service.

3. The method of claim 2, wherein the service request is formatted according to a service description language.

4. The method of claim 3, wherein the service description language is a Web Services Description Language (WSDL).

5. The method of claim 2, wherein the name service is registered in a UDDI registry.

6. The method of claim 1, wherein the gaming client comprises a gaming machine.

7. The method of claim 1, wherein the gaming client comprises a service provider.

11. The method of claim 1, further comprising returning a name binding to the gaming client.

12. The method of claim 11, wherein the name binding comprises a TCP/IP binding.

13. The method of claim 11, wherein the name binding comprises a URL binding.

14. The method of claim 11, wherein the name binding comprises a file name binding.

15. A gaming network system providing a name service, the gaming network system comprising:

a gaming client communicably coupled to the gaming network;

a name service communicably coupled to the gaming network and operable to provide identification services using common names for devices on the gaming network to a plurality of gaming clients; and

a discovery agent communicably coupled to the gaming network, the discovery agent operable to:

receive service information from the name service,

determine if the name service is authentic and authorized for the gaming network, and

publish the service information to a service repository to make the name service available on the gaming network;

wherein the gaming client is operable to issue a request for the location of the name service to the discovery agent and use the service information received from the discovery agent to send one or more service requests to the name service;

wherein the name service is further operable to:

receiving the one or more service requests from the gaming client; and

processing the one or more service requests between the gaming client and the name service, said service requests conforming to an internetworking protocol.

16. The gaming network system of claim 15, wherein the name service comprises a web service.

17. The gaming network system of claim 16, wherein the service request is formatted according to a service description language.

18. The gaming network system of claim 17, wherein the service description language is a Web Services Description Language (WSDL).

19. The gaming network system of claim 16, wherein the name service is registered in a UDDI registry.

20. The gaming network system of claim 15, wherein the gaming client comprises a gaming machine.

21. The gaming network system of claim 15, wherein the gaming client comprises a service provider in the gaming network.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.